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6-2701

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In re Application of:) Art Unit: 1647
KOPCHICK, et al.) Examiner: SAOUD, C.
Serial No.: 08/488,164) Washington, D.C.
Filed: June 7, 1995) June 21, 2001
For: DNA ENCODING GROWTH) Docket No.: KOPCHICK=1E
HORMONE ANTAGONISTS)

ELECTION WITH TRAVERSE

Honorable Commissioner of Patents
Washington, D.C. 20231

S i r :

1. In response to the group restriction requirement mailed May 22, 2001, Applicants hereby elect group I with traverse.

As between groups (I) and (II), the subject matter are related as subcombination to combination. The patentability of the combination (the animal) is based on that of the subcombination (the DNA). So the I/II restriction is improper. See MPEP 806.05(c), especially part (II).

As between groups (II) and (III), Applicants conditionally traverse the restriction on the grounds that if a DNA claim of group (I) is found allowable, Applicants are entitled to amend the method-of-use claims in group (III) to be dependent on the allowed DNA claim and then have them rejoined, pursuant to MPEP 821.04.

From the "Conclusion" it appears that the Examiner agrees that there is allowable subject matter. And the Examiner is aware that some claims parallel already issued polypeptide claims.

2. In response to the species restriction, we hereby elect with traverse DNA molecules coding a growth hormone variant comprising an amino substitution of lysine for the amino acid corresponding to position 119 of bovine growth hormone, wherein the growth hormone variant has growth inhibitory activity. See

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claim 102.

If this election is deemed insufficiently specific, we further elect that the variant be a human growth hormone variant.

If this election is deemed insufficiently specific, we further elect that the variant is hGH (H18D, H21N, G120K, R167N, K168A, D171S, K172R, E174S, I179T), presently known in the art as "B2036". If there is a reason of law that we cannot elect this species, which is not explicitly set forth in our specification, we elect hGH (G120K) instead.

At least the following claims read on the elected species B2036: 10, 11, 14-18, 25-37, 40-46, 62, 63, 65-67, 70-74, 78, 80-99, 101, 105, 106, and new claims 107, and 109.

If we are forced to instead elect hGH (G120K), because B2036 is not explicitly set forth, the following claims read on hGH (G120K): 10-37, 40-46, 62, 63, 65-74, 78, 80-85, 88-99, 101, 106, and new claims 107, 108 and 109.

The species restriction is traversed on the grounds that generic claims are allowable.

The species restriction is also traversed on the ground of lack of undue burden. Claims 10-62, covering many different GH mutant sequences, were presented on March 14, 1997. Claims 10-44 and 62, drawn to the DNA and transformed cells (essentially the present group I), were examined on their merits on July 22, 1997, without any species restriction. This implies that the Examiner searched not only the generic subject matter, but also all claims directed to subgenera or species.

Claims 63 and 64 were added January 22, 1998, and claims 65-73 on November 10, 1998. These new claims were likewise all examined on their merits, on November 6, 1998.

Claim 74 was added November 8, 1999. A third, complete action on the merits followed (January 31, 2000).

Claims 75-106 were added on July 28, 2000. Once again, all of the new claims were examined, see October 24, 2000 supplemental office action.

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Subsequently, Applicants filed a response (on November 29, 2000) which did not amend or cancel any claims. Nonetheless, the instant action all of a sudden finds grounds for imposing a species, restriction requirement, even though all group I claims have been examined on the merits at least once, and some have been examined as many as four times! Hence, there is no "serious burden" in examining all of these claims. See MPEP §803.

The species restriction is also traversed on the grounds that the species are "related" by virtue of their sequence similarity and common biological activity. See MPEP §806.04(b), 808.01(a), and 808.02. However, we do not make any admission of lack of patentable distinctness between species.

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: KOPCHICK, et al.
Serial No.: 08/000,164
Filed: June 7, 1999
For: DNA ENCODING GROWTH HORMONE ANTAGONISTS

Art Unit: 1647
Examiner: SAQUD, C.
Washington, D.C.
Atty.'s Docket: KOPCHICK=1E
Date: June 21, 2001

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THE COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Sir:

Transmitted herewith is an [] Amendment [XX] Election with Traverse and Preliminary Amendment
in the above-identified application.

[XX] Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.

[] A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.

[] No additional fee is required.

The fee has been calculated as shown below:

(Col. 1)	(Col. 2)	(Col. 3)	Small Entity	Other Than a Small Entity
Claims Remaining After Amendment	Highest No. Previously Paid For	Present Extra	Rate	Additional Fee
Total 87	Minus 80	7	x 9	\$ 63.00
Indep. 13	Minus 8	5	x40	\$200.00
First Presentation of Multiple Dependent Claim			135	\$ +270
TOTAL ADDITIONAL CLAIMS FEE				\$263.00

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col.1 of a prior amendment of the number of claims originally filed.

[XX] Conditional Petition for Extension of Time

If any extension of time for a response is required applicant requests that this be considered a petition therefor.

[] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

- [] First - \$ 55.00
[] Second - \$195.00
[] Third - \$445.00
[] Fourth - \$695.00

Other Than Small Entity

Response Filed Within

- [] First - \$ 110.00
[] Second - \$ 390.00
[] Third - \$ 890.00
[] Fourth - \$1390.00

[] Less fees (\$) already paid for months extension of time on .

[] Please charge my Deposit Account No. 02-4035 in the amount of \$. A duplicate copy of this sheet is attached.

[] A check in the amount of \$ is attached (check no.).

[XX] Credit Card Payment Form, PTO-2038, authorizing payment in the amount of \$263.00 is attached. ✓

[XX] The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR Section 1.16 and all patent processing fees under 37 CFR Section 1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR Section 1.18.

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